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10/559,808	03/14/2006	Anne Dez	Q91408	7355
23373 7590 09/15/2010 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER KOEHLER, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
3726				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/559,808

Applicant(s)

DEZ ET AL.

Examiner

Christopher M. Koehler

Art Unit

3726

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 12-14, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishii et al. (US Patent No. 6,722,174).

Claim 12-14 and 18:

Nishii teaches a method for continuous direct casting of a metal (steel, ferrous; col. 7, lines 40-45) strip (20) according to which said strip is cast by solidification of liquid metal in an ingot mould with cooled, moving walls (col. 7, lines 40-63 and col. 2, lines 31-43; 1, figures 9 and 14), said strip (20) is then given in-line hot rolling (col. 20, lines 39-54, coll. 22, line 63-col. 23, line 10), wherein a product is applied to the surface of the strip as it exits the ingot mould, which leaves a lubricant layer on said surface

subsisting during the time the strip is hot rolled and causing release of gases contributing towards the protection of said surface from oxidation comprising a carbonaceous material, graphite (col. 16, lines 43-59).

Claim 19:

Nishii teaches a plant for the continuous direct casting (col. 7, lines 40-63; 1, figures 9 and 14) of a thin metal strip (20), of the type comprising an ingot mould with cooled, moving walls in which solidification of said strip occurs (col. 2, lines 31-43; 1, figures 9 and 14), and an in-line hot rolling unit (figures 9 and 14) for said solidified strip (col. 20, lines 39-54, col. 22, line 63-col. 23, line 10), wherein it comprises means for applying a product to the surface of said strip as it exits the ingot mould which leaves a lubricant layer subsisting on said surface as it enters the hot rolling unit (col. 16, lines 43-59).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of Goto et al. (US Patent No. 5,352,373).

Claim 15:

Nishii teaches that the carbonaceous lubricant is graphite but does not disclose that the lubricant may comprise a grease containing calcium carbonate. Goto teaches

that acceptable lubricants include graphite (col. 5, lines 64-65) but more preferably an oil containing calcium carbonate (col. 3, lines 16-45) for hot rolling of metal slabs (col. 1, lines 6-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the lubrications of Goto in the method of Nishii in order to effectively prevent galling, scale formation and roll wear (Goto, col. 2, lines 9-30)

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of DuBois et al. (US Patent No. 3,048,540).

Claim 16:

Nishii teaches that the carbonaceous lubricant is graphite but does not disclose that the lubricant may comprise acetylene. DuBois teaches the use of lubricants comprising grease (col. 1, lines 30-37) and acetylene black (col. 1, line 68-col. 2, line 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the lubrications of DuBois in the method of Nishii because of the greases superior working stability and water resistance properties (DuBois, col. 5, lines 36-40)

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of Sheu et al. (US Patent No. 5,508,119).

Claim 17:

Nishii teaches that the reduction rate of the hot-rolling process is not less than 30% (col. 7, line 64-col. 8, line 20) but does not explicitly teach that it is at least 50%. Sheu teaches that the hot rolling of a carbonaceous lubricated metal sheet (col. 2, line

51-col. 3, line 45) can achieve reduction ratios on the order of 35-60% (col. 10, lines 45-62). It would have been obvious to one of ordinary skill in the art at the time of the invention in light of the ratio teachings of Sheu that Nishii is capable of at least 50% reduction ratios.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of Takeuchi et al. (US Patent No. 6,145,581).

Claim 20:

Nishii teaches the use of rotary continuous casting machines (col. col. 2, lines 31-43) but does not explicitly describe their construction. Takeuchi teaches a rotary continuous casting machine (figure 1) wherein the moving walls are the sides of two rolls (1a, 1b) rotating in opposite directions (figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to look to Takeuchi to describe a detailed structure of rotary casting machines used in Nishii.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii.

Claim 21:

Nishii teaches the invention cited with the exception of the moving walls comprising belts. At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used belts because applicant has not disclosed that the use of belts provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the rotary casting taught by Nishii or the claimed belt casting because either

continuous casting technique performs the same function of continuously casting a metal slab equally well. Therefore, it would have been an obvious matter of design choice to modify Nishii to obtain the invention specified in claim 21.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of Applicant Admitted Prior Art (AAPA, Background of Specification).

Claim 22:

Nishii teaches the continuous casting, lubricating and hot-rolling method above but does not explicitly teach an inertization chamber for the strip between its exit from the ingot mold and its entry into the hot-rolling unit. AAPA teaches that it is well known in the art to use inertization chambers between continuous casting rolls and the rolling mill (specification page 1, line 28-page 2, line 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided an inertization chamber as taught by AAPA in the process of Nishii in order to further ensure that oxidation of the slab is prevented.

Response to Arguments

10. Applicant's arguments filed 6/28/2010 have been fully considered but they are not persuasive.

Anticipation of claim 12 in view of Nishii:

Applicant argues that Nishii teaches processing a "slab" and not a "thin strip". Claim 12 only requires a "metal strip" which is not further defined in the claim and therefore encompasses a metal "slab" as long as it is in strip form.

Anticipation of claim 19 in view of Nishii:

One notable distinction between claims 12 and 19 is that claim 19 does require casting of a "thin metal strip", however, there is no clear definition how thick or thin the "thin metal strip" is as claimed. Therefore, the examiner believes that 100-200 mm is sufficiently thin to anticipate the term "thin metal strip".

Nishii in view of Goto:

Applicant argues that the carbonate plays only a marginal part in the lubrication of Goto and therefore does not meet the limitations of claim 15. Nevertheless, the examiner maintains that it would have been obvious to one of ordinary skill in the art to use the lubricant of Goto in the method of Nishii and the calcium carbonate is a part thereof, therefore meeting the limitations of the claim.

Nishii in view of Sheu:

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571)272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jermie E Cozart/
Primary Examiner, Art Unit 3726

/C. M. K./
Examiner, Art Unit 3726